

In the Claims: (strikethrough parts deleted and underlined parts added)

1. (Currently Amended) A submersible ice fishing troller system, comprising:
a submersible unit in communication with a control unit;
a downrigger clip attached to said submersible unit; and
a line release attached to said submersible unit, wherein said line release has a first jaw
and a second jaw that form an opening that slidably receives a fishing line when in a closed
position and for selectively releasing a fishing line when in an open position.
2. (Original) The submersible ice fishing troller system of Claim 1, wherein said line
release includes an actuator unit mechanically connected to said first jaw and said second jaw.
3. (Original) The submersible ice fishing troller system of Claim 1, wherein said first
jaw and said second jaw form an enclosed circular structure when closed.
4. (Original) The submersible ice fishing troller system of Claim 1, wherein said first
jaw and said second jaw each have a C-shaped structure.
5. (Original) The submersible ice fishing troller system of Claim 1, wherein said line
release is attached to a rear portion of said submersible unit.
6. (Original) The submersible ice fishing troller system of Claim 1, wherein said
submersible unit automatically travels to the bottom of an ice floor after said line release has
been opened.
7. (Original) The submersible ice fishing troller system of Claim 1, wherein said line
release is attached to one of a plurality of control fins of said submersible unit.
8. (Original) The submersible ice fishing troller system of Claim 1, wherein said
submersible unit includes at least a first sonar.

9. (Original) The submersible ice fishing troller system of Claim 1, wherein said control unit has a release switch for allowing a user to control the opening of said line release.

10. (Original) The submersible ice fishing troller system of Claim 1, wherein said control unit includes a joystick for allowing control of said submersible.

11. (Currently Amended) A submersible ice fishing troller system, comprising:
a submersible unit in communication with a control unit; and
a line release attached to said submersible unit, wherein said line release has a first jaw and a second jaw that form an opening that slidably receives a fishing line when in a closed position and for selectively releasing a fishing line when in an open position.

12. (Original) The submersible ice fishing troller system of Claim 11, wherein said line release includes an actuator unit mechanically connected to said first jaw and said second jaw.

13. (Original) The submersible ice fishing troller system of Claim 11, wherein said first jaw and said second jaw form an enclosed circular structure when closed.

14. (Original) The submersible ice fishing troller system of Claim 11, wherein said first jaw and said second jaw each have a C-shaped structure.

15. (Original) The submersible ice fishing troller system of Claim 11, wherein said line release is attached to a rear portion of said submersible unit.

16. (Original) The submersible ice fishing troller system of Claim 11, wherein said submersible unit automatically travels to the bottom of an ice floor after said line release has been opened.

17. (Original) The submersible ice fishing troller system of Claim 11, wherein said line release is attached to one of a plurality of control fins of said submersible unit.

18. (Original) The submersible ice fishing troller system of Claim 11, wherein said submersible unit includes at least a first sonar.

19. (Original) The submersible ice fishing troller system of Claim 11, wherein said control unit has a release switch for allowing a user to control the opening of said line release.

20. (Original) The submersible ice fishing troller system of Claim 11, wherein said control unit includes a joystick for allowing control of said submersible.

C. APPLICANT'S COMMENTS

Claims 1-20 are pending in this Application and Claims 1, 11 being amended. No new matter is added by way of these amendments, and the amendments are supported throughout the Specification and the drawings. Reconsideration of Claims 1-20 is respectfully requested.

The Examiner's rejections will be considered in the order of their occurrence in the Official Action.

Paragraphs 1-2 of the Official Action

The Official Action rejected Claims 1-8, 11-18 under 35 U.S.C. §103(a) as being unpatentable over **Mechling** in view of **Lowden** or **Combs**. The Applicant respectfully disagrees with this rejection of these claims, particularly as independent Claims 1, 11 are now amended.

In proceedings before the United States Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. *In re Bell*, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993). *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). When references cited by the Examiner fail to establish a prima facie case of obviousness, the rejection is improper and will be overturned upon appeal. *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

"To establish a prima facie case of obviousness, three basic criteria must be met." MPEP §706.02(j). First, there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a **reasonable expectation**

of success. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The law regarding *obviousness* is clear -- any modification of the prior art must be suggested or motivated by the prior art. It is submitted that combining elements from different prior art references (in an attempt to establish obviousness) must be motivated or suggested by the prior art.

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious -- there must be a motivation provided by the prior art.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person*." Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original).

Amended independent Claim 11 (and Claim 1 with additional features) has the following features:¹

11. (Currently Amended) A submersible ice fishing troller system, comprising:
a **submersible unit** in communication with a **control unit**; and
a **line release** attached to said submersible unit, wherein said line release has a **first jaw and a second jaw that form an opening that slidably receives a fishing line when in a closed position and for selectively releasing a fishing line when in an open position.**

Mechling merely teaches an “ice fishing lure transport” that has a conventional “lure coupler (14)” which is a “line release coupler that is a commonly known item of fishing tackle that may be typically used with down riggers and the like.” (Column 3, Lines 39-42; See Figures 2 and 4). **Mechling** does not teach a line release with a first jaw and a second jaw. (Paragraph 3, 2nd Page of the 1st Official Action). The Official Action relies solely upon **Lowden** and **Combs** to provide support for a line release with a first jaw and a second jaw.

However, **Lowden** merely teaches a “fish line release mechanism” with a “line release mechanism 14” that has a body 18 constructed of a resilient material with a cable passage 20 and a narrow slit 22 extending into the body to the cable passage. (Column 3, Lines 6-22; See Figures 3 through 7). **Lowden** does not teach a first jaw and a second jaw. Figures 3 and 4 illustrate a first embodiment where the cable extends freely through the “cable passage 20” without any jaws to open or release the line. Figures 5 and 6 illustrate a pair of “rectangular clamp pads 40” that are comprised of rubber wherein a “clamp screw 42” tightens the clamp pads 40 upon a downrigger cable 16 for “**frictionally clamping the pads and the mechanism 14 to the cable 16.**” (Starting at Column 3, Line 51 and continuing to Column 4, Line 7). In other words, **Lowden** does not teach a line release “wherein said line release has a **first jaw and a second jaw that form an opening that slidably receives a fishing line when in a closed position and for selectively releasing a fishing line when in an open position.**” This is a

¹ Independent Claim 1 has the same features along with “a downrigger clip attached to said submersible unit.”

significant feature of the present invention which is not shown in Mechling or Lowden which should not be overlooked by the Examiner.

In addition, Combs merely teaches an “adjustable fishing line release” that is comprised of a “friction gripping jaw type”. (Abstract and Title). More particularly, Combs merely teaches a pair of “jaws 11” that “utilize two rubber type pads 12 and 13 **which firmly hold a fishing line in place.**” (Column 3, Lines 15-17; See Figure 1). As with Lowden, Combs does not teach a line release “wherein said line release has a **first jaw and a second jaw that form an opening that slidably receives a fishing line when in a closed position and for selectively releasing a fishing line when in an open position.**” This is a significant feature of the present invention which is not shown in Mechling or Combs which should not be overlooked by the Examiner.

First, there is **no suggestion or motivation**, in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. All of the references teach a line release structure that “frictionally” engages the fishing line to prevent movement of the fishing line. The present invention has a line release that has a first jaw and a second jaw forming a central opening when closed to allow the fishing line to freely (i.e. non-frictional) slide through the same to increase bite sensitivity while using live bait and for providing the ability to “jig” (i.e. lift and drop) the bait/lure.

Second, there is **no reasonable expectation of success** of modifying or combining the references. As stated previously, the prior art references are designed for “frictionally” engaging the fishing line. Only Figure 3 of Lowden discusses allowing any movement of the downrigger cable within a passage; however Lowden does not teach the usage of a first jaw and a second jaw to allow for the selective release/closing about the fishing line as is specifically taught in the present invention. There is nothing in Lowden that would even come close to allowing a modification to what the present invention has claimed.